

REMARKS

New Fig. 6, which shows aspects of the invention in a exploded fashion, has been added and it is fully supported by the original specification, drawings and claims. For example see page 4 lines 6-10, and original claims 10 and 11. **If fact, new Fig. 6 is Fig. 5 with the matter identified as 43 removed, thus no new matter has been added.**

The specification has been amended to add a description of Fig. 6. The added subject matter is fully supported by the original specification and drawings. For example, see page 4 lines 6-10, and original claims 10 and 11.

112 rejection

Claims 18-21 were rejected under 35 U.S.C. 112, first paragraph as being non-enabling. This rejection is respectfully traversed. Using a press-on/catch closure is described at page 4 lines 6-10 as being the preferred means for attaching the housings. It is also stated therein that such a connection can be used without a special tool being required. Further, new Fig. 6 and its attendant description, which is not new matter and is based on the original specification, fully supports these claims. One skilled in the art is fully enabled by the specification and drawings to make and use the invention. Accordingly this rejection should properly be withdrawn. The Examiner is misapplying the law. If fact, the Examiner has provided no support that one skill in the art may not combine features of different embodiment to arrive at a variation, which is within the scope of the invention. The application has expressed such that "the present invention may include novel feature or combination of features disclosed herein either explicitly or implicitly."

The case law supports Applicants' view.

"It does not seem, under established procedure of long standing, approved by this court, to be any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there." (*In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537, at 542 (C.C.P.A. 1962). The court ruled in *Wolfensperger*.

"In establishing a disclosure applicant may rely not only on the specification and drawing as filed but **also on the original claims** if their content justifies it. (**Emphasis added**)

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be new matter within the meaning of this law. If the drawing, then contains the necessary disclosure, it can form the basis of a valid claim."

The specification is not required to be a production specification. The specification need only explain how to make and use the invention without undue experimentation. *Vaeck*, 947 F.2d at 495, 20 USPQ2d at 1444; *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404; *In re Fisher*, 427 F.2d 833, at 839, 166 USPQ 18, 24 (CCPA 1970). (The first paragraph of section 112 requires that the scope of protection sought in a claim bear a reasonable correlation to the scope of enablement provided by the specification). Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples. *In re Marzocchi*, 439 F.2d 220 at 223, 169 USPQ 367 at 369 (CCPA 1971). The Examiner has failed to meet the burden of showing how the "written description" which includes the claims failed to show how a person skilled in the art after reading the specification including the claims would need to use undue experimentation to practice the invention as defined by claims 18 - 21.

In light of the above citations, Applicant respectfully reproduces below claims 10 & 11 from the priority application:

10. An electronic radiotelephone as claimed in any preceding claim, comprising at least one key unit for user-actuation of a key sensor, and wherein when the second housing is released from attachment with the first housing the key unit is free to move with respect to the first housing.
11. An electronic radio telephone as claimed in any preceding claim, comprising at least one key unit for user-actuation of a key sensor, and wherein when the second housing is attached to the first housing the key unit is sandwiched between the second housing and the key sensor.

Since matter has been removed from Fig. 6 and not added and a key unit free to move is in the claims as filed, the rejection of claims 18-21 under 35 U.S.C. 112 should properly be withdrawn and Fig. 6 and the above amendment entered.

102(e) rejection

Claims 1-9, 11-12, and 15-17 were rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi. The claims as now drawn require a press-on/catch closure means which is neither taught nor suggested by Kobayashi. Accordingly these claims are not anticipated by Kobayashi and this rejection should properly be withdrawn.

103(a) rejections

Claims 1-9, 11-12, and 15-17 were rejected under 35 U.S.C. 103(a) as being as being unpatentable over Kobayashi in view of Semenik et al.. Semenik et al. does not correct the deficiencies in Kobayashi. The claims as now drawn require a press-on/catch closure means, which is neither taught nor suggested by Kobayashi. There is no disclosure, nor any suggestion whatsoever, that any of the phones disclosed in Kobayashi are intended to have user replaceable covers. Kobayashi deals with assembly the phones from a manufacturing standpoint not from the user's standpoint. Further, Kobayashi teaches away from user replaceable covers to change the appearance of the phone. Kobayashi teaches using the same assemblies during a manufacture process not the user being able to remove an old assembly and replace it with a new one. Similarly, Semenik et al also teaches away from user replaceable covers. The Examiner attention is directed to column 6, line 60 to column 7 line 25 and column 8 lines 4 to 35, teaching that, *inter alia*, "forces acting on the housing do not result in separation of the housing portions thereapart." A person of ordinary skill in the art would not look to Semenik for a press-on/catch closure to allow a user to easily remove a cover and replace same without using a tool. In fact, such a person of ordinary skill in the art would be discouraged from following the path set out in Semenik after reading how various forces cannot separate the housings. The housing assembly of Semenik is made to be fasten by the manufacturer without the user or any other force to easily unfasten the housing assembly.

Furthermore, It is well established that the Examiner must consider the claim as a whole and not a list of parts to be pieced together by using the claims as a guide. It

is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art.

Accordingly Kobayashi taken alone or in view of Semenik et al. would not teach or suggest or render obvious the invention of this claim and this rejection should properly be withdrawn.

Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kobayashi and Semenik et al. in view of Takagi et al. (US 5,235,636) Semenik et al. and Takagi et al. do not correct the deficiencies in Kobayashi as described above. There is no disclosure, nor any suggestion whatsoever, that any of the phones disclosed in Kobayashi, Semenik or Takagi are intended to have user replaceable covers. Accordingly Kobayashi taken alone, or in combination with Semenik, or in view of Takagi et al. would not teach or suggest or render obvious the invention of this claim and this rejection should properly be withdrawn.

Furthermore, it is well established that the Examiner must consider the claim as a whole and not a list of parts to be pieced together by using the claims as a guide. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art.

Accordingly Kobayashi taken alone, or in combination with Semenik, or in view of Takagi et al. would not teach or suggest or render obvious the invention of this claim and this rejection should properly be withdrawn.

To further demonstrate the novelty of a user replaceable cover without the need for the user to use a tool, attached as Appendix A is an article dated September 2000 from *WHAT MOBILE*, entitled "Karma Chameleon." This article documents the commercial success of Nokia's replaceable covers. To quote, "in 1998 Nokia came up with a truly inspirational idea, an entry-level phone with a completely interchangeable front cover that didn't mean reaching for a screwdriver."

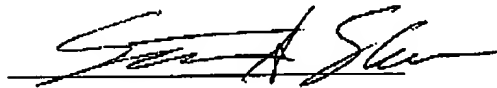
For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the

Examiner is invited to call Applicants' attorney at the telephone number indicated below.

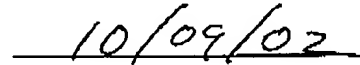
The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-0270.

Please note a new Power of Attorney has been filed on August 20, 2002 and the correspondence address has been changed to the address below.

Respectfully submitted,



Steven A. Shaw
Reg. No. 39,368



Date

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(972) 894-6173

Customer 26343

Application No.: 09/125,700

Marked Up Paragraph

The present invention will now be described, by way of example, with reference to the accompanying drawings, in which:

figure 1 shows a radiotelephone of a first embodiment with its external wall element removed;

figure 2 shows the radio telephone of figure 1 with the external wall element fitted;

figure 3 shows a view of the interior of housing 14 of the radiotelephone of figure 1;

figure 4 shows a cross-section through part of the housing of figure 3; and

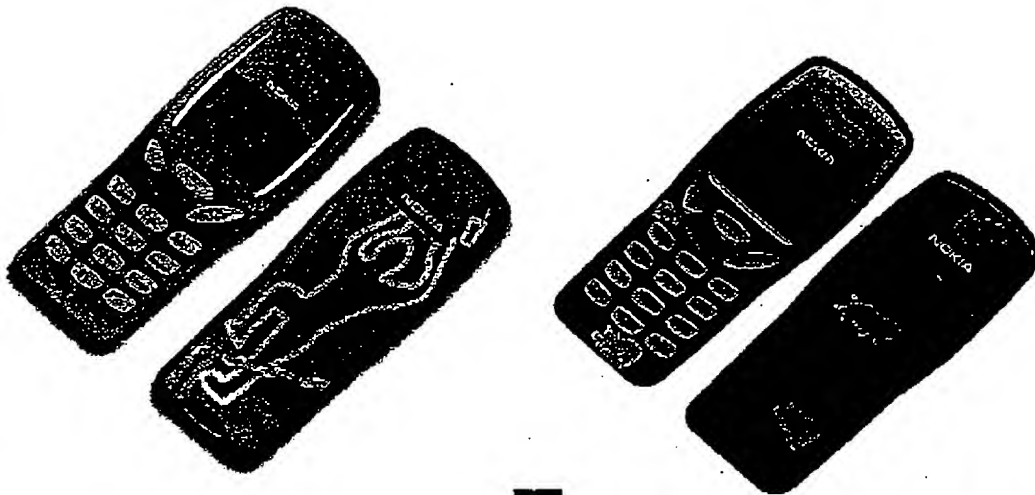
figure 5 shows an exploded view of a second embodiment of the invention; and

figure 6 shows an exploded view of an embodiment of the invention.

PH

changing fascias

David Chow is spoilt for choice as he picks out some colourful best sellers. Why stick with grey or blue when you can be a different person every day (at a price)



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karma chameleon



Nobody wants an ordinary phone in this day and age. Look around you and you'll see the hip and happening mobile phone-toting community bathed in a blaze of glorious colour, rather than a sea of anonymous grey and black boxes.

Nokia was probably the first ever manufacturer to offer an alternative look for its phones. Originally the company toyed with different fascias for its 2110 handset some five years ago, with some gorgeous wood and marble effect exteriors. The downside was the phone needed to be taken apart with special tools and few high street retailers were able to do this task without invalidating your warranty.

Then in 1998 Nokia came up with a truly inspirational idea, an entry-level phone with a completely interchangeable front cover that didn't mean reaching for

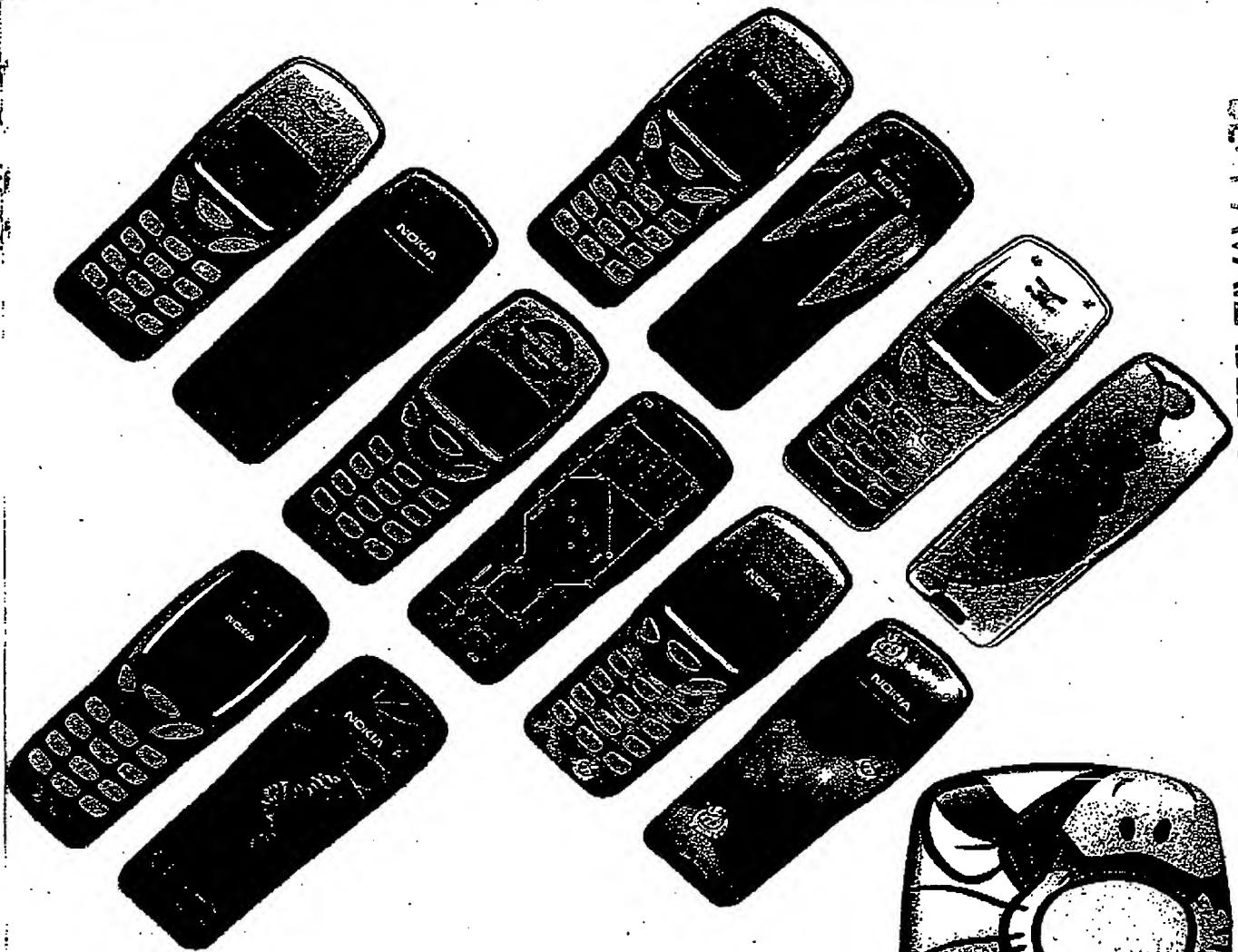
a screwdriver. The 5110 swappable fascia concept was born and went on to become an instant sales hit, especially with teenagers. Eighteen months later the Nokia 3210 with front and back replaceable covers offers the ultimate in personalised phones.

Nokia naturally produce a range of coloured and patterned covers for its phones, and occasionally release special edition covers for both the 5110 and 3210 (check out www.club.nokia.com for the latest on offer) for avid collectors. But for the demanding fascia addict there is a huge selection of third party covers available from specialist manufacturers. Just be aware there are some very good covers available and some downright cheap and nasty ones too.

The thing to notice is whether the cover you choose is approved by Nokia. You can

changing fascias

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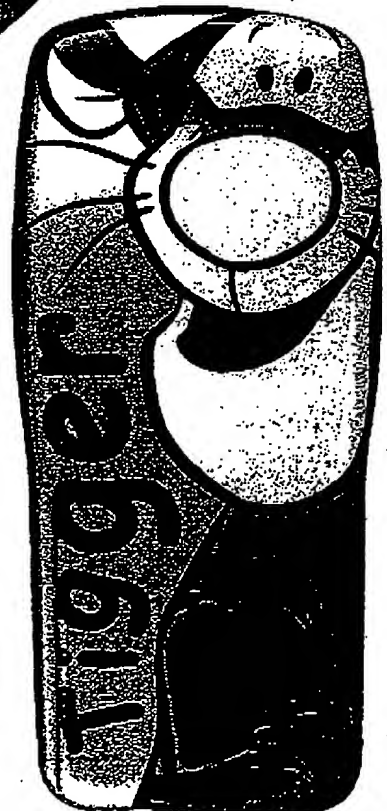
normally do this in instant, because non-genuine covers will have a lens screen with either a GSM logo or it will be blank. Only approved covers are allowed to bear the Nokia logo, front and back. Expect to pay around £25 to £30 for an approved cover.

It's not fair to knock third-party covers though because some have been cleverly engineered to incorporate active sliders or flips, which can answer or end your call. But all too often many replacement covers will be made of low-grade plastics and the paintwork will either rub off or is applied so thinly that when your phone's keypad lights up, so does your entire cover.

So needless to say What Mobile is a huge fan of Nokia OK approved covers and best of all, some of the most imaginative designs available are British. If you've got a genuine Nokia cover on your 5110 or 3210, chances are it's either from the creative sta-

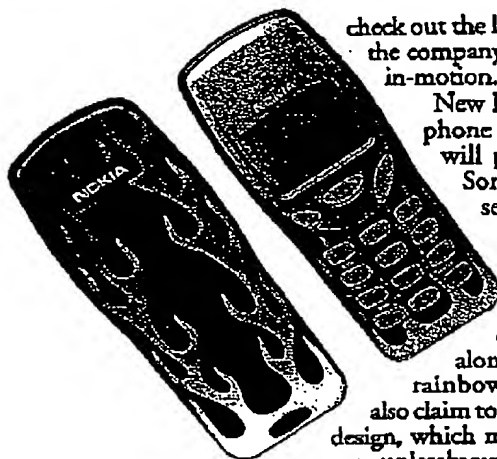
bles of Art In Motion, New Face Design or Xart. All of which provide best selling designer covers to the likes of the Carphone Warehouse, The Link and Vodafone stores.

Among Art In Motion's best sellers are the surreal flying pigs, funky flowers and their rendition of a sunflower is truly amazing. They also provide Harrods with its official fascia cover. Its designs are mainly icon art, but they also dabble in luminescent, fluorescent and even fur applied covers, although needless to say the latter doesn't conform to Nokia's approved painting scheme! Their latest ideas they are experimenting with are phones that stimulate the other senses aside from sight, with soft touch rubbers and also covers which have essential oils and perfumes embedded in them. Sadly they don't sell to the public, but you can



changing fascias

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check out the latest developments on the company website via www.art-in-motion.com.

New Face Design aren't just phone cover designers, they will paint anything, from Sony Playstations to toilet seats. They have about 20 designs for the 3210, and yet again their recently released Pigs design is a best seller, along with the flames and rainbow effect covers. They also claim to have the best lightning design, which may be true: the covers were completely out of stock when we tried to get one for photography.

But New Face reckons that graphic arts days are numbered. They are working on a top-secret process that will allow digitally scanned images to be painted on a fascia so that what you see is what you get. The nice thing about New Face is despite being so busy with creating its own designs it will consider one-off fascias for customers, but will only do them every couple of months when there is a quiet period. One day New Face hope to produce special computers for in-store use for customers to design their own fascias which are then sent to the factory by email and made in a few working days. Meanwhile, you can order the current range of covers on-line at www.newfaceart.com.

It comes as no surprise that some of the world's most famous brands, such as Disney and the London Underground are adorned on a Nokia fascia, but what is surprising is that they are made in Taiwan by non-approved manufacturers.

Character Mobile Phone Accessories will be producing Tigger, Winnie

The Pooh and of course Mickey Mouse 5110 and 3210 covers. They will also be producing matching headsets and pouches. The paintwork is smooth and even and the covers come complete with keypads, although they are made out of silicone rubber rather than the standard hard plastic keypad supplied by Nokia. The downside is the fit of the covers is not brilliant and as a conse-

quence are very difficult to remove. The not so wonderful thing about Tigger! They will be available in high street stores such as Argos and John Lewis for around £20 or by mail order on 08000 686718.

London Underground covers from Image Communication are of variable quality. White covers are decorated with the 'Underground' logo on the earpiece while black covers have the 'Mind the gap' slogan. But to keep the price low (RRP £15-20) you have to 'build' the cover yourself by sticking the foam shock absorbers on. The choice of materials were variable, including a screen which was bordering on opaque and uneven paintwork in places. To nit-pick, there is a huge indent at Notting Hill Gate where the back badge normally resides. Oh and the whole tube map isn't reproduced. Image Communications counters this by saying 'If you put the whole map on the back of the phone you probably wouldn't be able to read it.' True. Besides, if you are really stumped, the London Transport information hotline is printed at the bottom of each cover.

But arguably the king of cool in cover designs is Xart. They were the first Nokia OK approved manufacturer in the UK and it shows. Some of their designs border on the surreal, but most deserve a place in the Modern Tate gallery or the very least, the Saatchi private collection. For the last two years Xart has provided special fascias for London Fashion week based on sketches penned by famous designers like Bella Freud and Jean Paul Gaultier. And when the Nokia 3210 launched, Xart produced some very special one-off covers for What Mobile as drawn by you, our readers, in an exclusive competition. Sadly, unless you've got a couple of hundred pounds burning a hole in your pocket Xart doesn't really have the time to do one-off designs.

Football football football

Latest in-house designs include the 'phone victim' runover man, and some mad swirly versions of the Union Jack. They are licensed to produce covers Liverpool and Arsenal football clubs, and have just signed a deal to produce the new Man United cover with Vodafone livery.

Xart also produces covers for formula one drivers, Jenson Button, Johnny Herbert and Superbike champion, Carl Foggy Fogarty and are promising some exciting covers in conjunction with some 'high profile' brands.

Originally you could only buy Xart covers from shops, but they've finally got a website (www.xchoosyours.com) with on-line ordering facilities.

